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No. 80-1497

In the Supreme Court of the United States

OCTOBER TERM, 1980

AB TURN-O-MATIC,
Petitioner,
vs.
SVEN TVETER,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

Petitioner's Reply Memorandum

The Court of Appeals and Respondent Are Responsible for the Application of the Synergism Test

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Respondent Tveter, like the Court of Appeals, attempts to put the blame for the court's reliance upon the nonstatutory ground of "synergism" upon petitioner. Respondent Tveter, in his opposing brief at page 6, relies upon the Court of Appeals statement that the petitioner contended that the patent in suit met the not "obvious" standard be-

cause the combination of old elements is synergistic. Respondent Tveter was the party who interjected the requirement of synergism into this case to define a patentable invention. In his Proposed Findings of Fact and Conclusions of Law and Judgment submitted prior to the commencement of trial, Tveter set forth as his proposed conclusion of law No. 6:

> "U.S. Letters Patent No. 3,885,724 being a combination patent, it fails to satisfy the severe test that the whole of the matter sought to be patented exceeds the sum of the parts to produce unusual or surprising results from the unification of the elements and, therefore, does not define a patentable invention."

Respondent submitted an identical proposed conclusion of law at the end of trial and then carried the argument to the Ninth Circuit Court of Appeals stating in Respondent's brief at page 44:

> "The Ninth Circuit, in construing the mandate of the U.S. Supreme Court in the *Great A & P Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147 (1950); *Anderson's Black Rock v. Pavement Co.*, 396 U.S. 57 (1960), has held that claims directed to a combination of elements must satisfy the severe test that the whole of the matter sought to be patented must exceed the sum of the parts to produce an unexpected, unusual or surprising result from the unification of the elements to define a patentable invention. (*Alcor Aviation, Inc. v. Radair Incorporated*, 527 F.2d 113 (1975); *Regimbal v. Scymansky*, 444 F.2d 333 (9th Cir. 1971); *Santa Anita Mfg. Co. v. Lugast et al.*, 369 F.2d 964 (9th Cir. 1967); *Bentley v. Sunset House Distr. Co.*, 359 F.2d 140 (9th Cir. 1966); *Burgess & Associates, Inc. v. Klingensmith, supra.*)"

Respondent established through evidence at the trial that to the extent a synergistic result can exist in a combination,

a synergistic result was achieved with petitioner's patented ticket dispenser. The findings by the trial court are Nos. 44 and 79 and conclusion No. 22, found respectively at pages 43, 55 and 109 of the Appendix of the Petition. The synergistic result is not merely only that summarized in the isolated quote from the trial transcript made by the Ninth Circuit Court of Appeals which appears at page 11 of the Appendix of Petition.

It is believed that at respondent's urging the Ninth Circuit Court of Appeals did, in fact, reach a conclusion that a synergistic result was required and even summarily reversed the determination of the District Court that a synergistic result did exist with petitioner's dispenser.

Under the interpretation by the First Circuit in *International Tel. and Tel. Corp. v. Raychem Corp.*[1] and the Sixth Circuit in *Hanson v. Alpine Valley Ski Area, Inc.*[2] that synergism is a sufficient condition for patentability, the District Court's determination of a synergistic result in the present case would establish validity of the patent in suit.

The District Court Did Not Simply Adopt Petitioner's Proposed Findings and Conclusions

On page 8 of his Opposition Brief Respondent Tveter misrepresents to this Court the background and development of the findings of fact and conclusions of law established at trial. Tveter made extensive objections to the findings and conclusions which the Magistrate adopted after final arguments and review. The objections were thoroughly briefed by the parties (Record 886-917, 928-1055) and were referred to and argued before the Magistrate. As

1. 538 F.2d 453, 457 (1st Cir. 1976).
2. 611 F.2d 156, 160 (6th Cir. 1979).

a result one duplicative finding was deleted and changes were made in two conclusions of law which changed the language of the judgment.

At the conclusion of the hearing on Tveter's objections to the findings of fact and conclusions of law adopted by the Magistrate, the Magistrate stated:

> "Now if I reject the defendants' proposal [of findings], it is based on two things: Number one, I found not that your witness told a lie, but that your evidence was not as believable as the plaintiffs', or that if there is a conflict I had to accept one and reject the other. And I did precisely that. I didn't find Mr. Tveter to be particularly persuasive. I was very interested in Mr. Tveter going to the plastic designer and in a very short period of time out comes a plastic container that has all of the—or just about all the interior configurations that the plaintiff's machine had." (Petitioner's Brief on Appeal, p. 12)

CONCLUSION

It is believed that this case presents the issue of the requirement and/or sufficiency of "synergism" in determination of patent validity on which the Circuits are vastly divided and in conflict.

Respectfully submitted,

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